

HORI -- Appln. No. 09/867,418
Attorney Docket: 061063-0281359

REMARKS

Claims 1-20 are pending.

Claims 1-7, 17, 18 and 20 were rejected under 35 U.S.C. § 102(e) over Nakagawa et al. The rejection is respectfully traversed.

Claim 1 recites an evaluation method for polycrystalline silicon which is used as a material for pulling single crystal silicon, the method including immersing a predetermined amount of polycrystalline silicon in a predetermined amount of an agent contained in a vessel, which agent is capable of dissolving polycrystalline silicon, and placing a measuring device in the agent having the polycrystalline silicon dissolved therein to count the number of foreign particles dispersed in the agent.

Nakagawa et al. cannot anticipate or render obvious claim 1 because Nakagawa et al. do not disclose or suggest placing a measuring device in an agent having polycrystalline silicon dissolved therein to count the number of foreign particles dispersed in the agent. Nakagawa et al. disclose using a four probe method to measure the specific resistance of a silicon crystal epitaxially grown on a substrate. The four probe method disclosed by Nakagawa et al. is neither placed in an agent having polycrystalline silicon dispersed therein nor placed to count the number of foreign particles dispersed in the agent.

In the response filed November 5, 2003, on page 6, lines 3-5, Applicants clearly argued that there is no disclosure or suggestion by Nakagawa et al. of placing a measuring device in an agent having polycrystalline silicon dissolved therein to count the number of foreign particles dispersed in the agent. The January 29, 2004 Office Action, on page 4, lines 9-11, stated: "Applicants state Nakagawa et al. fails to teach placing a measuring device within the silicone [sic]. The Office maintains Nakagawa et al. teaches placement of a probe in the silicon which has been properly read on the claims."

Applicants respectfully note that they have never argued that Nakagawa et al. fails to teach placing a measuring device within silicon. Applicants claim placing a measuring device in an agent having polycrystalline silicon dissolved therein. Applicants argued then, and reiterate the argument now, that Nakagawa et al. do not disclose or suggest this claimed feature.

MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ 1051 (Fed. Cir. 1987)) states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

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The examiner is respectfully requested to clarify and explain how Nakagawa et al.'s use of a four probe method to measure the specific resistance of an epitaxially grown silicon crystal "has been properly read on" placing a measuring device into an agent having polycrystalline silicon dissolved therein to count the number of foreign particles dispersed in the agent. As stated in MPEP § 707.07(f): "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In the absence of such an answer, it is respectfully submitted that the rejection must be withdrawn.

Claims 2-20 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein. In addition, Padovani et al., Okada et al. and JP '230 all fail to cure the deficiencies of Nakagawa et al. discussed above with respect to claim 1, and even assuming it would have been obvious to combine the references, such a combination would not have resulted in the claimed invention.

Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the above remarks, Applicants respectfully submit that all of the claims are allowable and that the entire application is in condition for allowance.

Should the examiner believe that anything further is desirable to place the application in better condition for allowance, the examiner is invited to contact the undersigned at the telephone number listed.

Respectfully submitted,
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